

### REMARKS

The Office Action dated February 12, 2004 has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claim 8 has been amended to place that claim in independent form by incorporating the subject matter of claims 1 and 7. No new matter has been added, and no new issues have been raised which require further consideration and/or search. Claims 1-4 and 6-9 are pending and are respectfully submitted for consideration.

In the subject Office Action, claims 8 and 9 were objected to as being dependent on a rejected base claim, but indicated as being allowable if place in independent format. Claim 8 has been placed in independent form and should be allowed, along with claim 9 that depends therefrom. Entry of the above amendment is respectfully requested for at least the reason that the amendment will reduce the number of issues on appeal.

Claims 1-6 were rejected under 35 USC § 102(e) as being anticipated by *Hughes et al.* (U.S. Patent No. 6,526,060). Applicants note that only claims 1-3 and 6 are directly addressed in the body of the rejection and claim 4 is separately rejected in another rejection. It appears that the rejection was intended to be made against only 1-3 and 6. Additionally, claim 4 was rejected under 35 USC § 103(a) as being unpatentable over *et al.* in view of *Hoffman et al.* (U.S. Patent No. 6,094,435) and claim 7 was rejected under 35 USC § 103(a) as being unpatentable over *et al.* in view of *Kloth et al.* (U.S. Patent No.

6,643,260). Applicants respectfully submit that the presently pending claims recite subject matter which is neither disclosed nor suggested in the cited prior art.

Claim 1, from which claims 2-4, 6 and 7 depend, recites a network switch for switching packets from a source to a destination. The network switch includes a source port for receiving an incoming packet from a source, a destination port which contains a path to a destination for the packet and a programmable counter unit for counting a number of packets of selected packet types which are received by the switch. The programmable counter unit includes a rules table therein, the rules table storing rules which control packet flow based on values set in fields of a selected packet type, after a number of counted packets of a selected packet type exceeds a predetermined threshold.

In the anticipation rejection, it is alleged that all of the elements of claims 1-3 and 6 are taught by *Hughes et al.* *Hughes et al.* is directed to a service controller for a cell switched network services. The Office Action points to BMX 300, in Fig. 2 and 3, where ATM cells are received and a fair rate for servicing the cells from a plurality of queues is determined. Cells are moved to their proper class of service queue according to that fair rate. The Office Action also alleges that the system also includes an algorithm to count the number of cells and determine whether they exceed threshold values. However, *Hughes et al.* fails to teach or suggest all of the elements of claim 1.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.

1987). Claim 1 recites, in part, “wherein the programmable counter unit includes a rules table therein, said rules table storing rules which control packet flow based on values set in fields of a selected packet type.” *Hughes et al.* simply fails to teach suggest an element.

*Hughes et al.* fails to disclose a rules table nor the use of any such table by a counter to control packet flow. While it could be argued that *Hughes et al.* evaluates the ATM cells received to determine, for example, a class of service, there is nothing in the reference that teaches or suggests the inclusion or use of a rules table. It could also be argued that *Hughes et al.* discloses that the system distributes and monitors cells to the class of service queues, but there is no teaching of the use of a rules table in performing such a function. Given this lack of disclosure, Applicants respectfully assert that the rejection of claim 1 as being anticipated by *Hughes et al.* is improper and should be withdrawn.

Additionally, the Office Action rejects claim 2 as being anticipated by *Hughes et al.* and argues that *Hughes et al.* discloses, inherently, “a filter unit in order to select and arrange into queues corresponding type of cell.” However, claim 2 recites, in part, “a filter unit which parses selected fields of an incoming packet and *compares the selected field to a table* to determine whether the incoming packet is of a selected packet type.” Similarly to what was argued above, *Hughes et al.* fails to teach the comparison of fields with a table, as recited in claim 2. While the Office may argue that a filter unit is inherently disclosed by *Hughes et al.*, all elements of a claim must be found for the claim

to be anticipated. Thus, even if it were acknowledged that *Hughes et al.* inherently discloses a filter unit, that inherent disclosure cannot teach the functioning of that unit, including the comparisons that unit may make with a table. Applicants respectfully assert that the rejection of claim 2 as being anticipated by *Hughes et al.* is improper and should be withdrawn.

In addition to the anticipation rejection of the claims over *Hughes et al.* being improper, Applicants also respectfully assert that the rejected claims are also not rendered obvious in view of *Hughes et al.* There would be no reason for one of ordinary skill in the art to modify the system of *Hughes et al.* to reach the subject matter of claim 1. The inclusion of a rules table into *Hughes et al.* would not improve the functioning of that system. The system is designed to institute a fair rate for the class of service queues and the use of a rules table would only hinder the efficiency of that function. As such, Applicants respectfully assert that claims 1-3 and 6 would not be rendered obvious over the disclosure of *Hughes et al.*

With respect to the rejection of claims 4 and 7, the Office acknowledges the deficiencies of *Hughes et al.* and cites *Hoffman et al.* and *Kloth et al.* *Hoffman et al.* is cited as teaching elements of claim 4 and *Kloth et al.* is cited as teaching a new code point. Even if these teachings were accepted, which Applicants do not admit, they would not cure the deficiencies of *Hughes et al.* noted above. Additionally, claims 4 and 7 depend from claim 1 and should be allowed for at least the same reasons discussed above. Reconsideration and withdrawal of the above rejections are respectfully requested.

It is further submitted that each of claims 1-4 and 7-9 recite subject matter which is neither disclosed nor suggested in the cited prior art. It is therefore respectfully requested that all of claims 1-4 and 7-9 be allowed, and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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